

Application No.: 09/889,167

REMARKS

The indication of allowable subject matter in claims 12 and 13 is acknowledged and appreciated. For the reasons that follow, it is respectfully submitted that all pending claims are patentable.

The Examiner objects to the Oath/Declaration. Enclosed is a Substitute Declaration which obviates the issue raised by the Examiner. Accordingly, it is respectfully requested that this objection be withdrawn.

Claim 14 stands rejected under 35 U.S.C. § 112, second paragraph. Claim 14 has been canceled without prejudice/disclaimer, rendering this rejection moot.

The specification and claims 12-13 are objected to for minor informalities. It is respectfully submitted that the enclosed amendment obviates the alleged informalities. Accordingly, it is respectfully requested that these objections be withdrawn.

Claims 6, 8 and 11 are independent and stand rejected under 35 U.S.C. § 103 as being unpatentable over newly cited Scheidt et al. '902 in view of AAPA. This rejection is respectfully traversed for the following reasons.

Each of claims 6, 8 and 11 embody a "non-contact type IC." Support for this feature can be found, for example, on page 20, lines 8+ of Applicants' specification. According to the claimed configuration, data stored in the IC can be read by simply passing the articles near a data reader. Scheidt is silent as to the alleged IC being a non-contact type. Indeed, in direct contrast

Application No.: 09/889,167

to the present invention, Scheidt teaches away from the present invention and discloses only using a contact-type IC in that the alleged IC's (memories 2a-5a) *are connected* to an external reading device via a data bus 9 and diagnostic connector 10 (col. 3, lines 13-17; Figure 1).

The Examiner is directed to MPEP § 2143.03 under the section entitled "All Claim Limitations Must Be Taught or Suggested", which sets forth the applicable standard for establishing obviousness under § 103:

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. (emphasis added) (citing *In re Royka*, 180 USPQ 580 (CCPA 1974)).

In the instant case, the pending rejection does not "establish *prima facie* obviousness of [the] claimed invention" as recited in the pending claims because the cited prior art fails the "all the claim limitations" standard required under § 103.

Under Federal Circuit guidelines, a dependent claim is nonobvious if the independent claim upon which it depends is allowable because all the limitations of the independent claim are contained in the dependent claims, *Hartness International Inc. v. Simplimatic Engineering Co.*, 819 F.2d at 1100, 1108 (Fed. Cir. 1987). Accordingly, as the independent claims are patentable for the reasons set forth above, it is respectfully submitted that all claims dependent thereon are also patentable. In addition, it is respectfully submitted that the dependent claims are patentable based on their own merits by adding novel and non-obvious features to the combination.

Based on the foregoing, it is respectfully submitted that all pending claims are patentable over the cited prior art. Accordingly, it is respectfully requested that the rejection under 35 U.S.C. § 103 be withdrawn.

Application No.: 09/889,167

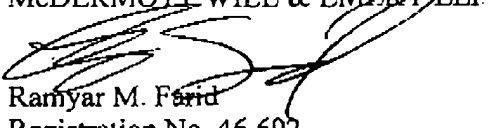
CONCLUSION

Having fully and completely responded to the Office Action, Applicants submit that all of the claims are now in condition for allowance, an indication of which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, the Examiner is requested to call Applicants' attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP


Ramyar M. Farid
Registration No. 46,692

600 13th Street, N.W.
Washington, DC 20005-3096
Phone: 202.756.8000 RMF:MWE
Facsimile: 202.756.8087
Date: April 16, 2008

**Please recognize our Customer No. 53080
as our correspondence address.**